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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,801	02/09/2006	Stuart Norman Lile Bennett	101181-1P US	3056
44992 7590 11/20/2008 ASTRAZENECA R&D BOSTON 35 GATEHOUSE DRIVE WALTHAM, MA 02451-1215				
EXAMINER				
YOUNG, SHAWQUITA				
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
11/20/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/567,801

**Applicant(s)**

BENNETT ET AL.

**Examiner**

SHAWQUA YOUNG

**Art Unit**

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 March 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-8,10 and 16-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,2,4-8,10 and 16-20 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1, 2, 4-8, 10 and 16-20 are currently pending in the instant application.

#### **I. Response to Arguments/Remarks**

Applicants' amendment, filed on March 28, 2008, has overcome the rejection of claim 16 under 35 USC 112, first paragraph for failing to comply with the written description requirement for the term "activated derivative" and the rejection of claim 18 under 35 USC 112, first paragraph for failing to comply with the enablement requirement. The above rejections have been withdrawn.

#### **II. Rejection(s)**

##### ***Double Patenting***

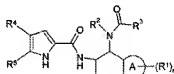
The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with

37 CFR 3.73(b).

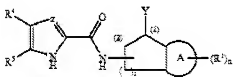
Claims 1, 2, 4-8, 10, 16, 18, 19 and 20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 ,6-8, 10, 11 and 13-15 of U.S. Patent No. 7,122,567. Although the conflicting claims are not identical, they are not patentably distinct from each other because:



Applicants claim a compound of the formula 1  
wherein all variables are as defined in claim 1.

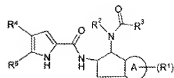
*Determining the Scope and Content of the Issued Patent*

Claim 1 of the issued patent claims a compound of the formula ,



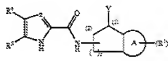
wherein all variables are as defined in claim 1 of the issued patent (See columns 97-99).

*Ascertaining the Differences Between the Instant Application and the Issued Patent*



The instant application claims a compound of the formula 1

, wherein  $R^2$  is selected from various substituents including alkyl (i.e. methyl) whereas



the issued patent claims a compound of the formula

wherein Y

can be  $NR^2R^3$  wherein one of  $R^2$  and  $R^3$  can be  $COR^8$  and the other can be hydrogen or  $C_{1-4}$  alkyl. See example 59 for an example (column 83).

#### Finding Prima Facie Obviousness

The genus compound of the issued encompasses the narrower genus compound of the instant claims 1, 2, 4-8, 10, 16, 19 and 20. The scope of the compounds in the patented claims 1-4, 6-8, 10, 11 and 13-15 and the scope of the claims 1, 2, 4-8, 10, 16, 19 and 20 of the instant application overlap and include patented subject matter in the instant claims. It was well established, in In re Wood, 199 USPQ 137, that hydrogen and methyl are deemed obvious variants absent unexpected results. So it would have been obvious to prepare the instant compounds wherein  $R^2$  is an alkyl group (i.e. methyl) when the issued patent claims similar compounds wherein the group  $R^2$  can be a hydrogen or an alkyl group (parallel to the instant compounds  $R^2$ ). Therefore, one of ordinary skill in the art would be motivated to prepare and claim the scope of the compounds in the instant claims again in the instant application since the scope already patented embraces the full scope of the instant claims 1, 2, 4-8, 10, 16, 19 and 20. As a

result, the claims are rejected under obviousness-type double patenting.

***Claim Rejections - 35 USC § 112, second paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 17 is an independent claim which contains the limitation "a compound of formula (1)" but Applicants have failed to include the structure of formula 1.

**III. Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawquia Young whose telephone number is 571-272-9043. The examiner can normally be reached on 7:00 AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Shawquia Young/

Examiner, Art Unit 1626

/Kamal A Saeed/

Primary Examiner, Art Unit 1626